

REMARKS

The claims remaining in the application are claims 1-5, 10-13, 15-21 and 23-25.

It is believed that the objection to claims 23-25 has been overcome by correction of the obviously inadvertent error.

The following rejections under 35 USC § 103 have now been applied to the claims:

claims 1-5, 12, 13, 15, 16, 18 and 23-25 over GB 9224457 ('457) in view of Harreus;

claims 10 and 11 over '457 in view of Harreus and Ishii et al., US 5,965,651 (Ishii);

claims 17 and 19-21 over '457 in view of Harreus and Cade.

These rejections are all respectfully traversed.

Except for reliance on '457 and Ishii, the same rejections were of record against the original claims. The errors in those rejections were discussed extensively in applicants' response. The reasons that the newly cited references do not remedy the defects in the original rejections are presented below.

The polymers described in '457 differ from those of Harreus in that the vinyl acetate portion of the polymers is not subject to partial hydrolysis. By consequence, the polymers have different properties. For instance, the polymer according to Ex. 1 of '457 is said to be soft and sticky (page 4, lines 81, 82). Such a polymer can not be used for manufacturing hard capsules with good dimensional stability. Also, the polymers described in '457 must be water-insoluble since they can be precipitated in water or can be extracted with water for purification (see, for instance, Ex. 2, 3, 4, 6, 7, etc.). Such polymers are not suitable for hard capsules, since a capsule made from such a polymer can not dissolve sufficiently. Thus, it could not have been obvious to use the '457 polymers for making capsules, since the polymers are soft and sticky and water-

insoluble. A skilled person wanting to make hard capsules and looking for guidance in the prior art would not consider the teaching of this document in any way helpful.

Capsule polymers as disclosed by Harreus in which the polyether-containing part shows molecular weights over 10,000, or preferably over 20,000 have the disadvantage that the resulting capsules are not sufficiently dimensionally stable. As is shown in comparative examples 15 and 17 on page 30 of the present specification, capsules obtained from polymers with a high-molecular weight polyether portion and no further comonomer are not dimensionally stable. In view of this a skilled person would never draw the conclusion to combine the teachings of '457 and Harreus.

Apart from the fact that the polymers based on N-vinylcarboxamides are chemically essentially different from the polymers used for the instant invention, Ishii relates to liquid-absorbing materials, i.e., materials very different in their behavior compared to the materials of the claimed invention. Liquid absorbing materials will not dissolve or disperse rapidly in water as do the claimed hard capsules. To the contrary, liquid-absorbing materials will remain stable and retain the liquid, water being one of the liquids that can be retained (see col. 2, lines 5-7). In view of this mere fact that the materials described in this document include crosslinking agents is meaningless with regard to obviousness. A skilled person will not consider the teaching of this document since it relates to a quite different technical problem. Thus, the skilled person will not combine the teachings of '457 and Harreus with Ishii's teaching.

The rejections set forth by the examiner epitomize the type of impermissible hindsight cautioned against in MPEP § 2142, second paragraph. The combination of the disclosures of the references as the examiner sets them forth can be carried out only with the application of impermissible hindsight, dissection of the references and

reassembling the bits and pieces thereof so obtained. It has long been held that such a procedure in formulating a rejection under 35 USC § 103 is completely improper. See, merely for example, *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1480-81, 1 USPQ2d 1241, 1246 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987) and *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 874, 228 USPQ 90, 99 (Fed. Cir. 1985).

For the reasons set forth in applicants' first response and supplemented herein, it is believed that the rejections of record have been obviated, and allowance of this application is respectfully requested.

A check to cover the one month extension fee of \$110.00 is attached.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11-0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

23. (currently amended) A [soft] hard capsule as claimed in claim 13, wherein said polyamino acids are selected from the group consisting of gelatin, zein, soybean protein and derivatives thereof.
24. (currently amended) A [soft] hard capsule as claimed in claim 13, wherein said polysaccharides are selected from the group consisting of starch, degraded starch, maltodextrins, carboxymethylstarch, cellulose, hydroxypropylmethylcellulose, hydroxypropylcellulose, hydroxyethylcellulose, methylcellulose, carboxymethylcellulose, ethylcellulose, cellulose acetate, cellulose acetate phthalate, hydroxypropylcellulose acetate phthalate, hydroxypropylcellulose acetate succinate, hemicellulose, galactomannans, pectins, alginates, carrageenans, xanthan, gellan, dextran, curdlan, pullulan, gum arabic, chitin, and derivatives thereof.
25. (currently amended) A [soft] hard capsule as claimed in claim 13, where said synthetic polymers are selected from the group consisting of polyacrylic acid, polymethacrylic acid, copolymers of acrylic esters and methacrylic esters, polyvinyl alcohols, polyvinyl acetate, polyethylene glycols, polyoxyethylene/polyoxypropylene block copolymers, polyvinylpyrrolidones and derivatives thereof.